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Docket No.: RIGHTLN.001A

January 17, 2006

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TRANSMITTAL LETTER

APPEAL BRIEF

Applicant : Reeder, et al.
App. No : 10/035,347
Filed : December 28, 2001
For : INTEGRATED MEDIA
MANAGEMENT AND RIGHTS
DISTRIBUTION APPARATUS
Examiner : Mary Da Zhi Wang Cheung
Art Unit : 3621

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David N. Weiss, Reg. No. 41,371

Mail Stop Appeal Brief - Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

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(X) Appeal Brief in 28 pages.

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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Dated: January 17, 2006



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APPEAL BRIEF

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Mail Stop Appeal Brief-Patents

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Alexandria, VA 22313-1450

Sir:

In accordance with the Notice of Appeal filed October 18, 2005, Applicant submits this Appeal Brief.

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I. REAL PARTY IN INTEREST

The real party in interest in the present application is Rightsline, Inc.

II. RELATED APPEALS AND INTERFERENCES

There are no related pending appeals or interferences.

III. STATUS OF CLAIMS

Claims 1-29 are pending in the present application. Claims 1-29, which are listed in the attached claims appendix, are the subject of this appeal.

IV. STATUS OF AMENDMENTS

No amendments were made in response to the Final Office Action.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The present application includes three independent claims. Each independent claim is paraphrased below, with citations to corresponding portions of the specification and drawings. These citations are provided in order to illustrate specific examples and embodiments of the recited claim language and related environments, and not to limit the claims.

Independent Claim 1 is directed to a media rights licensing apparatus (see, e.g., 100, 108, Fig. 1). The media rights licensing apparatus comprises:

- a rights owner application configured to execute on a computer configured to receive workflow rules, pricing rules, payment rules, and a license request template defined by a rights owner (see, e.g., 102, Fig. 1; and page 6, line 25, to page 9, line 18).
- a repository database coupled to the rights owner application, wherein the repository is configured to store the workflow rules, pricing rules and license request templates defined by the rights owner (see, e.g., 104, Fig.1; and page 6, line 25, to page 9, line 18).

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- a rights exchange application coupled to the repository database (see, e.g., 108, Fig. 1; and page 6, line 25, to page 9, line 18).
- The rights exchange application is configured to:
- receive a licensing request from a potential licensee related to a first media property (see, e.g., 302, Fig. 3A; and page 19, line 6 to page 19, line 21);
- conduct a licensing transaction of at least a first right associated with the first media property by determining rights available for the first media property by searching the repository database (see, e.g., 302, Fig. 3A; and page 19, line 6 to page 19, line 21);
- present a first license template defined by the rights owner (see, e.g., 304, Fig. 3A; and page 19, line 6 to page 19, line 21);
- receive first license template entries from the potential licensee (see, e.g., 304, Fig. 3A; and page 19, line 6, to page 19, line 21);
- transmit in real-time the first license template entries to the rights owner (see, e.g., 310, Fig. 3A; and page 20, lines 11-27);
- receive from the rights owner approval of a license for the first right, and to transmit the approval to the potential licensee (see, e.g., 318, Fig. 3A; and page 21, lines 16-23).

Independent Claim 11 is directed to a method of managing and licensing rights associated with media (see, e.g., Figs. 2 and 3A-B; and page 9, line 19, to page 24, line 2). The method of managing and licensing rights associated with media comprises:

- receiving from a rights licensor of a first media an instruction defined which system entities and entity attributes can be used as search parameters by a search engine (see page 18, lines 5-11; and page 19, lines 6-13);
- receiving from the rights licensor a definition of information types that a potential licensee is to provide in a license request submission for at least a first right for the first media (see, 226, Fig. 2; and page 10, line 25, to page 11, line 12);

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- receiving from the rights licensor a definition of at least a portion of a licensing transaction workflow to be used in a licensing transaction for at least the first right (see, e.g., 226, 228, 230, Fig. 2; page 6, lines to 8; page 10, line 25, to page 11, line 15; and page 18, line 12, to page 19, line 3);
- receiving from the rights licensor instructions as to what notifications are to be provided to the rights licensor and to the potential licensee during the licensing transaction (see, e.g., page 18, lines 10 to 27);
- receiving from the rights licensor authorizing instructions configured to specify who is authorized to perform predetermined acts during the licensing transaction (see, e.g., 234, Fig. 2; and page 12, line 17, to page 13, line 13); and
- conducting the licensing transaction in accordance with the rights licensor's notification instructions, rights licensor defined workflow, and authorizing instructions (see, e.g., Figs. 3A-B; and page 17, line 29, to page 24, line 2).

Independent Claim 25 is directed to an apparatus for managing licensing transactions related to media rights (see, e.g., 100, 108, Fig. 1). The apparatus comprises:

a first instruction stored in computer readable memory, the first instruction configured to transmit over the network to the user licensing terms defined by the licensor for a first media property (see, e.g., Fig. 1; and page 19, lines 6, to page 19, line 21);

a second instruction stored in computer readable memory, the second instruction configured to receive over a network a license inquiry from a user regarding at least a first right for the first media property (see, e.g., Fig. 1; and page 19, lines 6, to page 19, line 21);

a third instruction stored in computer readable memory, the third instruction configured to receive a user response to the licensing terms, the user response including one of a license acceptance, a counteroffer, and an indication that the user is not proceeding with the licensing transaction (see, e.g., Fig. 1; and page 21, lines 15-26);

a fourth instruction stored in computer readable memory, the fourth instruction configured to set a first status in real-time related to the first right at least partly in response to the user response (see, e.g., Fig. 1; and page 22, lines 11-13);

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a fifth instruction stored in computer readable memory, the fifth instruction configured to transmit a notification relating to the user response to a recipient designated by the licensor (see, e.g., Fig. 1; and page 22, lines 11-17); and

a sixth instruction stored in computer readable memory, the sixth instruction configured to receive an instruction from the licensor after transmitting the notification, and at least partly in response to the instruction, to set a second status related to the first right (see, e.g., Fig. 1; and page 22, lines 18-25).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The following grounds of rejection are to be reviewed on appeal:

1. The rejection of Claims 7-9, 11-12, 14-20, and 24-25 under 35 USC § 102(e) as being anticipated by U.S. Patent No. 6,189,146 to Misra et al ("Misra").
2. The rejection of Claim 26-28 under 35 USC § 103(a) as being unpatentable over Misra.
3. The rejection of Claims 1-6, 13, 21-23 and 29 under 35 USC § 103(a) as being unpatentable over Misra in view of U.S. Patent No. 5,940,504 to Griswold.
4. The rejection of Claim 10 under 35 USC § 103(a) as being unpatentable over Misra in view of U.S. Patent No. 5,838,910 to Domenikos.

VII. ARGUMENT

1. The rejection of Claims 1-7, 10, and 11 under 35 U.S.C. § 102(a) Over Misra

For the reasons set forth below, Appellants respectfully submit that the rejection of Claims 7-9, 11-12, 14-20, and 24-25 under 35 U.S.C. § 102(a) is improper.

A prior art reference does not anticipate the pending claims if it does not, alone, identically disclose each element of the Applicant's claims. MPEP § 2131; *See also, In re Attwood*, 148 USPQ 203, 210-211 (CCPA 1966). Even if the prior art disclosure is "substantially the same" as the claimed invention, anticipation may not be found. *Jamesbury Corp. v. Litton Industrial Products, Inc.*, 756 F.2d 1556, 1560, 225 USPQ 253, 256 (Fed. Cir. 1985). Only when a prior art reference claim either expressly or inherently describes each and

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every element as set forth in the claim should the claims be rejected as being anticipated. Verdegaal Bros., Inc. V. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ 2d. 1051, 1053 (Fed. Cir. 1987); *See generally, In re Oelrich*, 666 F.2d 578, 212 USPQ 323 (CCPA 1982).

Because Misra does not disclose, expressly or inherently, each claim element of Claims 7-9, 11-12, 14-20, and 24-25, Appellants submit that the rejection of these claims is improper.

Independent Claim 7

The rejection of Claim 7 is improper because, among other reasons, Misra does not either expressly or inherently describe a module configured to visually present to a first potential licensee a first license form including license terms defined by the first intellectual property rights licensor, or a module configured to visually present to a second potential licensee a second license form including license terms defined by the second intellectual property rights licensor. Claim 7 is reproduced below.

7. A system for managing intellectual property rights, comprising:

a first module configured to receive over a network information related to intellectual property rights available for at least a first property from a first intellectual property rights licensor and for at least a second property from a second intellectual property owner;

a repository coupled to the first module, wherein the repository is configured to store the information related to the intellectual rights for the first property and the second property; and

a second module configured to:

visually present to a first potential licensee a first license form including license terms defined by the first intellectual property rights licensor;

receive data entered into the first license form by the first potential licensee, the data including a request to license a first right;

determine if the first right is available, and if the first right is available, to submit the first license request, including at least a portion of the received data, for approval;

transmit a first license approval to the first potential licensee;

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visually present to a second potential licensee a second license form including license terms defined by the second intellectual property rights licensor;

receive data entered into the second license form by the second potential licensee, the data including a request to license a second right;

determine if the second right is available, and if the second right is available, to submit the second license request, including at least a portion of the received data, for approval;

transmit a second license approval to the second potential licensee.

In asserting that Misra discloses a module configured to "visually present to a first potential licensee a first license form including license terms defined by the first intellectual property rights licensor" and "visually present to a second potential licensee a second license form including license terms defined by the second intellectual property rights licensor," the Examiner relies on Misra, col. 12, lines 40-45, col. 15, line 56, to col. 16, line 6, and Fig. 7. Appellants respectfully disagree with the Examiner's characterization of Misra.

Rather than inherently or expressly disclosing a module configured to visually present to a first potential licensee a first license form including license terms defined by a first intellectual property rights licensor, or to visually present to a second potential licensee a second license form including license terms defined by a second intellectual property rights licensor, Misra at col. 15, line 56, to col. 16, line 6, as cited by the Examiner, merely discloses:

"FIG. 7 shows a more detailed method for providing a platform challenge to the client. In this illustration, the intermediate server 32 is shown as the go between, with the forwarding steps omitted for ease of description. An aspect of platform validation is establishing the authenticity of the client. The system utilizes the client's executable image to generate a digital signature that uniquely identifies the client. As noted above, the client's executable image is available to the license server 28 because it is stored in the client image cache 120. When a client requests a software license from the license server, the client 30 submits a client software ID (step 220 in FIG. 7). The software ID is assigned by the software manufacturer/vendor to be unique for each client release. The client software ID is a bit field that contains a platform identifier, a vendor identifier, and a client revision field. The arrangement of the bits depends on how many platforms and clients are supported."

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Similarly, Misra, at col. 12, lines 40-45, is directed to generating unique server and client identifiers, and is not concerned with the visual presentation of license forms. Figure 7 further fails to disclose the visual presentation of license forms.

Thus, Misra discloses an automated platform challenge to a client computer system and is not concerned with, and does not disclose, the visual presentation of license forms. Therefore, even assuming, *arguendo*, that the secure license store 122 is a licensor as asserted by the Examiner, and that the platform challenge of Misra corresponds to a "a first license form" as argued by the Examiner, Misra does not expressly or inherently disclose a module configured to visually present to a first potential licensee a first license form including license terms defined by a first intellectual property rights licensor, or to visually present to a second potential licensee a second license form including license terms defined by a second intellectual property rights licensor.

Because Misra does not expressly or inherently describe each element in Claim 7, the rejection of Claim 7 is improper.

Dependent Claims 8-9

Because Claims 8 and 9 and depend from Claim 7, the rejection of Claims 8 and 9 are improper for at least the reasons set forth above for Claim 7.

Independent Claim 11

The rejection of Claim 11 is improper because, among other reasons, Misra does not either expressly or inherently describe electronically receiving from a rights licensor of a first media an instruction defining which system entities and entity attributes can be used as search parameters by a search engine; electronically receiving from a rights licensor instructions as to what human perceptible notifications are to be provided to the rights licensor and to the potential licensee during the licensing transaction; or electronically receiving from the rights licensor authorizing instructions configured to specify which person is authorized to perform predetermined acts during the licensing transaction. Claim 11 is reproduced below.

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11. A method of managing and licensing rights associated with media, the method comprising:

electronically receiving from a rights licensor of a first media an instruction defining which system entities and entity attributes can be used as search parameters by a search engine;

electronically receiving from the rights licensor a definition of information types that a potential licensee is to provide in a license request submission for at least a first right for the first media;

electronically receiving from the rights licensor instructions as to what human perceptible notifications are to be provided to the rights licensor and to the potential licensee during the licensing transaction;

electronically receiving from the rights licensor authorizing instructions configured to specify which person is authorized to perform predetermined acts during the licensing transaction; and

conducting, using a computer system, the licensing transaction in accordance with the rights licensor's notification instructions, and authorizing instructions.

With reference to the claim elements "electronically receiving from a rights licensor of a first media an instruction defining which system entities and entity attributes can be used as search parameters by a search engine," the Examiner asserts that the foregoing elements are disclosed by Misra at col. 10, line 45 – col. 11, line 30, and Figure 3. The Examiner does not make any attempt, however, to explain how or why the above-quoted elements of Claim 11 are disclosed by these sections of Misra, and Appellants respectfully disagree with the Examiner's characterization of Misra.

A careful review of the foregoing citation fails to disclose "electronically receiving from a rights licensor of a first media an instruction defining which system entities and entity attributes can be used as search parameters by a search engine." Instead, Misra at col. 10, line 45 – col. 11, line 30, merely discloses:

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The client authenticating module 124 compares the client executable image received from the client to the client executable image stored in the client image cache 120. The client is deemed authentic if the two images match. The client authenticating module 124 informs the granting module 126 when the client is authenticated.

The granting module 126 grants a software license from the secure license store 112 to the authenticated client. To prevent an issued license from being copied from machine to machine, the software license is assigned to a specific client by assigning a client ID to the license and including that ID within the license. The software license is also given a license ID. The license ID is associated with the client ID in the client assignment table 116 to track which client receives the issued license.

The license server 28, based on information derived from the license pack, fills in fields of a license data structure at the time the license is issued. As one example, the license data structure is implemented using an X.509 certificate, which is well known in the art. The license server 28 then digitally signs the software license using a signing key that is not disclosed to the client. Table 5 shows the data fields of a software license data structure.

....
As part of the granting process, the client assignment table 116 is updated to reflect that a particular license having a specific license ID is issued to a particular client having a specific client ID. Additionally, the number assigned field in the license pack table 114 is updated to reflect that another license has been assigned to a client.

Figure 3 of Misra further fails to disclose "electronically receiving from a rights licensor of a first media an instruction defining which system entities and entity attributes can be used as search parameters by a search engine."

With reference to the claim elements regarding electronically receiving from a rights licensor instructions as to what human perceptible notifications are to be provided to the rights licensor and to the potential licensee during the licensing transaction, the Examiner takes the position that the foregoing element is disclosed by Misra at col. 15, line 47 to col. 16, line 37, and Figs. 6-7. The Examiner argues that the foregoing element "is taught by Misra as according to the license instructions, the right licensor and the potential licensee send each other responses corresponding to the license request." Appellants respectfully disagree with the Examiner's characterization of Misra. A careful inspection of the citation relied on by the Examiner fails to disclose electronically receiving from a rights licensor instructions as to what human perceptible

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notifications are to be provided to the rights licensor and to the potential licensee during the licensing transaction. Indeed, the disclosure of Misra, at col. 15, line 47 to col. 16, line 37, and at Figs. 6-7, discusses an automated platform challenge interaction between a license server 28 and a client 30, and interactions between the client 30, a license generator 26, the license server 28, and an intermediate server 32. Hence, there would not appear to be a need for electronically receiving from a rights licensor instructions as to what human perceptible notifications are to be provided to the rights licensor and to the potential licensee during the licensing transaction as claimed.

Further, Misra fails to disclose or suggest electronically receiving from the rights licensor authorizing instructions configured to specify which person is authorized to perform predetermined acts during the licensing transaction, as claimed. While the Examiner asserts that the foregoing element is disclosed by Misra at col. 10, line 60 to col. 12, line 14, and col. 15, lines 4-28, and Figs. 3, 6, a careful review of the foregoing citation fails to disclose electronically receiving from the rights licensor authorizing instructions configured to specify which person is authorized to perform predetermined acts during the licensing transaction. Rather, the citations relied on by the Examiner appear to discuss automated interactions between a client 30, a license generator 26, a license server 28, and an intermediate server 32, and do not discuss acts by a person.

Because Misra does not expressly or inherently describe each element in Claim 11, the rejection of Claim 11 is improper.

Dependent Claims 12, 14-20, and 24

Because Claims 12, 14-20, and 24 depend from Claim 11, the rejection of Claims 12, 14-20, and 24 are improper for at least the reasons set forth above for Claim 11.

Independent Claim 25

As set forth below, the rejection of Claim 25 is improper because the applied reference does not either expressly or inherently describe each and every element of Claim 25. The claim is reproduced below.

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25. An apparatus for managing licensing transactions related to media rights, the apparatus comprising instructions stored in computer readable memory configured to:

transmit over a network to a first user first licensing terms defined by a licensor for a first media property;

receive over a network a license inquiry from a the first user regarding at least a first right for the first media property;

receive a response from the first user to the first licensing terms, the first user response including a license acceptance, a counteroffer, or an indication that the first user is not proceeding with the licensing transaction;

set a first status in real-time related to the first right at least partly in response to the first user response;

transmit a notification relating to the user response to a recipient designated by the licensor;

receive an instruction from the licensor after transmitting the notification, and at least partly in response to the instruction, to set a second status related to the first right;

transmit over a network to a second user second licensing terms defined by a licensor for a second media property, wherein the licensor for the second media property is not the same as the licensor for the first media property;

receive over a network a license inquiry from the second user regarding at least a second right for the second media property;

receive a response from the second user to the second licensing terms, the second user response including a license acceptance, a counteroffer, or an indication that the second user is not proceeding with the licensing transaction;

set a second status in real-time related to the second right at least partly in response to the second user response;

transmit a notification relating to the user response to a recipient designated by the licensor; and

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receive an instruction from the licensor after transmitting the notification, and at least partly in response to the instruction, to set a second status related to the second right.

For example, Misra fails to teach or suggest the element: "receive a response from the first user to the first licensing terms, the first user response including a license acceptance, a counteroffer, or an indication that the first user is not proceeding with the licensing transaction."

The Examiner takes the position that Misra, at col. 11, Table 5, col. 15, line 47 – col. 16, line 37, and Figures 3, 6-7, discloses receiving a user response to the licensing terms, the user response including one of a license acceptance, a counteroffer, and an indication that the user is not proceeding with the licensing transaction.

However, Misra, at Table 5, merely discloses a software license data structure, and does not disclose a user response including one of a license acceptance, a counteroffer, or an indication that the user is not proceeding with the licensing transaction. Further, Misra, at col. 15, line 47 col. 16, line 37, describes how the license server 28 processes an "improper" response from a client, and further describes validating the authenticity of the client. Thus, the license server 28 of Misra determines whether or not to proceed with the licensing process in the event that the client is not authenticated. Misra, at col. 15, line 47 col. 16, line 37, also does not disclose a user response including one of a license acceptance, a counteroffer, or an indication that the user is not proceeding with the licensing transaction. Figures 3, 6-7, similarly disclose the treatment of an authentication failure or a challenge failure, and do not teach or suggest a user response including one of a license acceptance, a counteroffer, or an indication that the user is not proceeding with the licensing transaction.

Because Misra fails to disclose a user response including one of a license acceptance, a counteroffer, or an indication that the user is not proceeding with the licensing transaction, Misra further fails to disclose the claim elements: "set a first status in real-time related to the first right at least partly in response to the first user response" and "transmit a notification relating to the user response to a recipient designated by the licensor."

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The Examiner asserts that the element "set a first status in real-time related to the first right at least partly in response to the first user response" is taught by Misra at col. 15, line 4 to col. 16, line 37, and that the element "transmit a notification relating to the user response to a recipient designated by the licensor" is taught by Misra at col. 14, lines 47, to col. 16, line 37, and Figs. 3, 6. The Examiner does not make any attempt, however, to explain how or why the above-quoted elements of Claim 11 are disclosed by these sections of Misra, and Appellants respectfully disagree with the Examiner's characterization of Misra.

A careful reading of Misra fails to disclose the elements: "set a first status in real-time related to the first right at least partly in response to the first user response" and "transmit a notification relating to the user response to a recipient designated by the licensor," in the context of the other claim elements. The citations relied on by the Examiner appear directed to determining if trusted information (including the platform type and client's public key) is proper, determine whether a client has already been issued to the client, issuing a license to a client if the client does not already have a license, digitally signing the license, and rejecting an improper response from the client. The citations do not appear to disclose setting a status related to a first right at least partly in response to a user response that includes one of a license acceptance, a counteroffer, or an indication that the user is not proceeding with the licensing transaction. Similarly, the citations do not appear to disclose transmitting a notification relating to the user response that includes one of a license acceptance, a counteroffer, or an indication that the user is not proceeding with the licensing transaction, to a recipient designated by the licensor.

Because Misra does not expressly or inherently describe each element in Claim 25, the rejection of Claim 25 is improper.

2. The rejection of Claims 26-28 stands under 35 USC § 103(a) as being unpatentable over Misra

Because Claims 26, 27 and 28 depend from Claim 25, the rejection of Claims 27 and 28 are improper for at least the reasons set forth above for Claim 25.

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In addition, with respect to Claim 26, Misra fails to teach or suggest a user inquiry that specifies a time period. The Examiner takes the position that, because Misra teaches a license term comprising a time period, that it would have been obvious to one of ordinary skill in the art to allow the user inquiry in Misra's teaching to include specifying a license time period so that the licensor can quickly match the user's inquiry. Appellants respectfully disagree with the Examiner. Misra fails to even disclose offering different license terms for a given software item to correspondingly different users. Thus, even if a user inquiry were modified as proposed by the Examiner to specify a license time period, the system disclosed by Misra would not attempt to match the user specified license time period. Thus, there would be no motivation to modify the license request of Misra as proposed by the Examiner to include a license time period. Therefore, for this reason as well, the rejection of Claim 26 is improper.

Further, with respect to Claim 27, Misra fails to teach or suggest that a user inquiry specifies a territory for the license, including a governmental and/or a geographic regional territory. The Examiner takes the position that, Misra teaches, at col.8, Table2, and col.15, line 66, to col. 16, line6, a territory for the license, and argues that it would have been obvious to one of ordinary skill in the art to allow the user inquiry in Misra's teaching to include a governmental and/or a geographic regional territory so that the licensor can quickly match the user's inquiry. Appellants respectfully disagree with the Examiner's characterization of Misra. Misra at col. 8, Table 2 merely list platform types (Windows, Non-Windows, Legacy, Direct-Connect) and does not discuss a governmental and/or a geographic regional license territory. Further, Misra, at col. 15, line 66, to col. 16, line 6, discloses a unique software ID bit field that contains a platform identifier, a vendor identifier, and a client revision field. The software ID does not specify a territory.

Because Misra fails to disclose a governmental and/or a geographic regional territory, there would be no motivation to modify Misra as proposed by the Examiner. Therefore, for this reason as well, the rejection of Claim 27 is improper.

Additionally, with respect to Claim 28, Misra fails to teach or suggest that a user inquiry specifies a media human language. The Examiner takes the position that it would have been

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obvious to one of ordinary skill in the art to allow the user inquiry in Misra's teaching to include specifying a media language that is a human language so that the user can easily interact with computer instructions. Appellants respectfully disagree with the Examiner. Misra fails to even disclose or suggest offering media or computer instructions in different human languages. Therefore, there would be no motivation to modify the inquiry of Misra to specify a human language or for the system of Misra to match such a specification. Therefore, for this reason as well, the rejection of Claim 28 is improper.

3. The rejection of Claims 1-6, 13, 21-23 and 29 under 35 USC § 103(a) as being unpatentable over Misra in view of Griswold.

Independent Claim 1

The rejection of Claim 1 is improper because, among other reasons, Misra and Griswold do not individually or collectively disclose or suggest a rights exchange application configured to "receive a licensing request manually provided by a potential human licensee related to a first media property;" "receive first license template entries manually provided by the potential licensee;" "cause a first license template defined by the rights owner to be visually presented to the potential human licensee," or "transmit in real-time the first license template entries to be visually presented to the rights owner," in the context of the other elements of Claim 1.

In order to establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. See MPEP § 2143.03. In this case, the combination of Misra and Griswold fail to satisfy this basic requirement. Claim 1 is reproduced below.

1. A media rights licensing apparatus, comprising:

a rights owner application stored in computer readable memory and configured to execute on a computer configured to receive pricing rules, payment rules, and a license request template defined by a rights owner;

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a repository database stored in computer readable memory and coupled to the rights owner application, wherein the repository is configured to store the pricing rules and license request templates defined by the rights owner; and

a rights exchange application stored in computer readable memory and coupled to the repository database, the rights exchange application configured to:

receive a licensing request manually provided by a potential human licensee related to a first media property;

conduct a licensing transaction of at least a first right associated with the first media property by determining rights available for the first media property by searching the repository database;

cause a first license template defined by the rights owner to be visually presented to the potential human licensee;

receive first license template entries manually provided by the potential licensee;

transmit in real-time the first license template entries to be visually presented to the rights owner;

receive from the rights owner approval of a license for the first right, and to transmit the approval to the potential licensee.

With respect to a rights exchange application configured to "receive a licensing request manually provided by a potential human licensee related to a first media property" and "receive first license template entries manually provided by the potential license," the Examiner admits that Misra fails to disclose that a license request and license template entries received from the licensee are manually provided. Nonetheless, the Examiner states that "manually provided information from one party to another party is well known in the art and traditional practice in the business, such as submitting paper document from one company to another company." The Examiner argues that it "would have been obvious to one of ordinary skill in the art to allow the

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license request and the license template entries in Misra's teaching to be provided manually by the licensee for simplifying the media rights licensing apparatus."

Appellants disagree with the Examiner's reasoning. The Examiner failed to provide any support for the assertion that the media rights licensing apparatus of Misra would be simplified if the licensee were to manually provide a license request and license template entries. Further, even assuming, *arguendo*, that the modification proposed by the Examiner would simplify the media rights licensing apparatus of Misra, the Examiner has failed to provide any reason why such a simplification would be desirable. Indeed, as discussed below, Misra appears to teach the desirability of automating the licensing of software.

Further, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). MPEP, § 2143.01. Here, Misra teaches that when "a client connects to a server, the client presents a valid license (if it has one). If the client does not have an appropriate license, the server assists the client in obtaining a license from the license server. This provides an *automated mechanism* for clients to obtain and license server to distribute licenses to clients." Col. 2, lines 62-67 (emphasis added). Similarly, Misra teaches "If the client does not have an appropriate license, the intermediate server 32 assists the client in obtaining a license from the license server 28. This provides an *automated mechanism* for distributing licenses to clients." Col. 4, lines 50-54 (emphasis added). Still further, Misra discloses "Software licenses are distributed to the client *automatically by the license server*." Col. 14, lines 54-55 (emphasis added). Here, Appellants submit that the modification proposed by the Examiner would change the principle under which the system disclosed by Misra appears designed to operate.

The rejection of Claim 1 is also improper because Misra does not disclose or suggest a rights exchange application configured to: "cause a first license template defined by the rights owner to be visually presented to the potential human licensee," or "transmit in real-time the first license template entries to be visually presented to the rights owner."

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The Examiner asserts that the Misra, a col. 14, line 64, to col. 15, line 3, and Figs. 3, 6-7, discloses the element: "cause a first license template defined by the rights owner to be visually presented to the potential human licensee." The Examiner does not make any attempt, however, to explain how or why the above-quoted elements of Claim 1 are disclosed or suggested by these sections of Misra, and Appellants respectfully disagree with the Examiner's characterization of Misra. Rather than disclosing causing a first license template defined by the rights owner to be visually presented to the potential human licensee, Misra, a col. 14, line 64, to col. 15, line 5, is directed to facilitating a client's initial connection to an intermediate server, and merely recites:

"FIG. 5 shows steps in a process that facilitates a client's initial connection to the intermediate server. The client connects to the intermediate server 32 to ask for services or data provided by the server. Prior to working with the client and providing access to files, the intermediate server 32 wants to verify first that the client has a valid software license issued by a recognized license server."

Figs. 3, 6-7 also fail to disclose causing a first license template defined by the rights owner to be visually presented to the potential human licensee.

Similarly, while the Examiner asserts that the Misra, a col. 15, lines 4-28 and Figs. 6-7, discloses the element "transmit in real-time the first license template entries to be visually presented to the rights owner," the Examiner does not make any attempt, however, to explain how or why the above-quoted elements of Claim 1 are disclosed or suggested by these sections of Misra, and Appellants respectfully disagree with the Examiner's characterization of Misra. Misra at col. 15, lines 4-28, merely discloses:

At step 196 in FIG. 6, the client responds to the challenge in a manner that provides trusted information about client, including the platform type and the client's public key. The response is passed to the intermediate server 32, which forwards it to the license server 28 (step 198).

At step 200 in FIG. 6, the license server determines whether the response is proper, and hence, whether the client is authentic. If the client is authenticated (i.e., the "yes" branch from step 200), the license server proceeds with granting a software license. The license server 28 first queries the secure license store 112 to determine if a license for that client has already been issued (step 202). This procedure accommodates the case in which the client has lost its valid software

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license. If a non-expired license is found, the license server 28 forwards it to the client 30.

Otherwise, the license server 28 attempts to allocate a software license for the client, assuming a non-assigned license still exists in the license pack. If a license can be allocated, the license server 28 retrieves a software license that is appropriate for the client's platform from the secure software store 112 and grants the software license to the client (step 204 in FIG. 6). The license server 28 adds a record to the client assignment table 116 and the corresponding number assigned field is updated to reflect one additional allocation.

The foregoing citation does not even mention visually presenting template entries to a licensor, much less the claim elements. Figs. 6-7 likewise fail to disclose transmitting in real-time license template entries to be visually presented to a rights owner.

Further, the Examiner admits that Misra fails to teach that a rights owner application receives pricing and payment rules. Nonetheless, the Examiner relies on Griswold to supply the missing elements.

However, Misra does not even mention pricing or payment rules. Therefore, even if Misra were to receive and store pricing or payment rules, Misra does not disclose using pricing or payment rules. Thus, the references do not support the Examiner's assertion regarding a motivation to combine.

In summary, because the Misra and Griswold do not disclose or suggest all of the elements of Claim 1, and because the Examiner has not identified an adequate suggestion or motivation to combine the references, the rejection of Claim 1 is improper and should be withdrawn.

Dependent Claims 2-6

Because Claims 2-6 depend from Claim 1, the rejection of Claims 2-6 are improper for at least the reasons set forth above for Claim 1.

In addition, with respect to Claim 2, the applied references neither teach nor suggest a rights search engine wherein the rights owner can configure which system entities and which attributes for the system entities can be used as searchable parameters by the search engine. While the Examiner asserts that the foregoing element is disclosed by Misra at col. 9, lines 29 –

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67, and col. 10, lines 53-59, the Examiner does not make any attempt, however, to explain how or why the above-quoted elements of Claim 2 are disclosed by these sections of Misra, and Appellants respectfully disagree with the Examiner's characterization of Misra. Misra, at col. 9, lines 29 -67, discloses a client assignment table, but does not disclose a rights search engine wherein the rights owner can configure which system entities and which attributes for the system entities can be used as searchable parameters by the search engine. Misra, at col. 10, lines 53-59, disclosing assigning a client ID and license ID, but does not teach or suggest the claim elements. Therefore, for this reason as well, the rejection of Claim 2 is improper.

Dependent Claims 13, 21-23

Because Claims 13, 21-23 depend from Claim 11, the rejection of Claims 13, 21-23 are improper for at least the reasons set forth above for Claim 11.

In addition, with respect to Claims 21 and 22, Misra fails to teach or suggest that the media is a movie or a musical performance. Misra is unconcerned with the licensing of entertainment media, and is instead directed to licensing software. Indeed, the Misra patent is titled "System and Method for Software Licensing". The systems and methods for licensing software disclosed by Misra do not appear to be usable for licensing a movie or a musical performance. Further, the motivation provided by the Examiner "to attract more users to use Misra's teaching" is not a proper motivation. For these reason as well, the rejection of Claims 21 and 22 are improper. Similarly, the rejection of Claim 23 is likewise improper.

4. The rejection of Claim 10 under 35 USC § 103(a) as being unpatentable over Misra in view of Domenikos.

Because Claim 10 depends from Claim 7, the rejection of Claim 10 is improper for at least the reasons set forth above for Claim 7.

VIII. CONCLUSION

For the reasons set forth above, the rejections of Claims 1-29 are improper and should be reversed.

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IX. CLAIMS APPENDIX

WHAT IS CLAIMED IS:

1. A media rights licensing apparatus, comprising:

a rights owner application stored in computer readable memory and configured to execute on a computer configured to receive pricing rules, payment rules, and a license request template defined by a rights owner;

a repository database stored in computer readable memory and coupled to the rights owner application, wherein the repository is configured to store the pricing rules and license request templates defined by the rights owner; and

a rights exchange application stored in computer readable memory and coupled to the repository database, the rights exchange application configured to:

receive a licensing request manually provided by a potential human licensee related to a first media property;

conduct a licensing transaction of at least a first right associated with the first media property by determining rights available for the first media property by searching the repository database;

cause a first license template defined by the rights owner to be visually presented to the potential human licensee;

receive first license template entries manually provided by the potential licensee;

transmit in real-time the first license template entries to be visually presented to the rights owner;

receive from the rights owner approval of a license for the first right, and to transmit the approval to the potential licensee.

2. The media rights licensing apparatus as defined in Claim 1, further comprising a rights search engine wherein the rights owner can configure which system entities and which attributes for the system entities can be used as searchable parameters by the search engine.

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3. The media rights licensing apparatus as defined in Claim 1, further comprising a license request template stored in computer readable memory and defined by the rights owner.

4. The media rights licensing apparatus as defined in Claim 1, further comprising a plurality of rules stored in computer readable memory and defined by the rights owner, the rules configured to define which media rights licensing apparatus users are authorized to perform predefined actions.

5. The media rights licensing apparatus as defined in Claim 4, wherein the predefined actions include one or more of accepting a licensing request, denying a licensing request, and negotiating a licensing request.

6. The media rights licensing apparatus as defined in Claim 1, further comprising a plurality of notifications stored in computer readable memory and defined by the rights owner, the plurality of notifications configured to be issued during the licensing process in response to criteria specified by the rights owner.

7. A system for managing intellectual property rights, comprising:

a first module configured to receive over a network information related to intellectual property rights available for at least a first property from a first intellectual property rights licensor and for at least a second property from a second intellectual property owner;

a repository coupled to the first module, wherein the repository is configured to store the information related to the intellectual rights for the first property and the second property; and

a second module configured to:

visually present to a first potential licensee a first license form including license terms defined by the first intellectual property rights licensor;

receive data entered into the first license form by the first potential licensee, the data including a request to license a first right;

determine if the first right is available, and if the first right is available, to submit the first license request, including at least a portion of the received data, for approval;

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transmit a first license approval to the first potential licensee;

visually present to a second potential licensee a second license form including license terms defined by the second intellectual property rights licensor;

receive data entered into the second license form by the second potential licensee, the data including a request to license a second right;

determine if the second right is available, and if the second right is available, to submit the second license request, including at least a portion of the received data, for approval;

transmit a second license approval to the second potential licensee.

8. The system as defined in Claim 7, wherein the license approval is provided by the licensor after the received data is transmitted to the licensor.

9. The system as defined in Claim 7, the repository is configured to indicate when the first right has been licensed to the potential licensee in real time.

10. The system as defined in Claim 7, wherein the repository is configured to determine the availability of intellectual property rights through bi-directional hierarchical navigation and implied data relations.

11. A method of managing and licensing rights associated with media, the method comprising:

electronically receiving from a rights licensor of a first media an instruction defining which system entities and entity attributes can be used as search parameters by a search engine;

electronically receiving from the rights licensor a definition of information types that a potential licensee is to provide in a license request submission for at least a first right for the first media;

electronically receiving from the rights licensor instructions as to what human perceptible notifications are to be provided to the rights licensor and to the potential licensee during the licensing transaction;

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electronically receiving from the rights licensor authorizing instructions configured to specify which person is authorized to perform predetermined acts during the licensing transaction; and

conducting, using a computer system, the licensing transaction in accordance with the rights licensor's notification instructions, and authorizing instructions.

12. The method as defined in Claim 11, further comprising receiving a licensing request over the Internet from the potential licensee.

13. The method as defined in Claim 11, further comprising electronically receiving from the rights licensor pricing, payment and delivery rules.

14. The method as defined in Claim 11, wherein the system entities include one or more of properties, rights, requests, agreements, licenses, quotes, agents, licensees, and licensors.

15. The method as defined in Claim 11, wherein the system attributes include one or more of a rating, a genre, a territory, a language, a term start, and a term end.

16. The method as defined in Claim 11, wherein the rights licensor uses a license template stored in computer readable memory to define the information types that the potential licensee is to provide.

17. The method as defined in Claim 11, wherein the rights licensor specifies how the notifications are to be provided and such licensor specification on how the notifications are to be provided is stored in computer readable memory.

18. The method as defined in Claim 11, wherein at least one of the notifications includes status information on the licensing transaction.

19. The method as defined in Claim 11, further comprising:

providing over a network a licensing form to the potential licensee requesting the information as defined by the rights licensor;

receiving over the network the requested information, including an indication as to what right the potential licensee wants to license, from the potential licensee;

determining, using a computer system, if the right the potential licensee wants to license is available;

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transmitting over the network at least a portion of the received requested information to the rights licensor;

receiving from the rights licensor a communication indicating if the potential licensee is granted the right the potential licensee wants to license, where such indication is stored in computer readable memory; and

electronically transmitting information related to the grant to the potential licensee.

20. The method as defined in Claim 19, wherein if the response from the rights licensor is a license approval, further comprising updating in real time a database stored in computer readable memory and used to store right status information.

21. The method as defined in Claim 11, wherein the first media is a movie.

22. The method as defined in Claim 11, wherein the first media is a musical performance.

23. The method as defined in Claim 11, wherein the first media is a photograph.

24. The method as defined in Claim 11, wherein the first media is a document.

25. An apparatus for managing licensing transactions related to media rights, the apparatus comprising instructions stored in computer readable memory configured to:
transmit over a network to a first user first licensing terms defined by a licensor for a first media property;

receive over a network a license inquiry from the first user regarding at least a first right for the first media property;

receive a response from the first user to the first licensing terms, the first user response including a license acceptance, a counteroffer, or an indication that the first user is not proceeding with the licensing transaction;

set a first status in real-time related to the first right at least partly in response to the first user response;

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transmit a notification relating to the user response to a recipient designated by the licensor; receive an instruction from the licensor after transmitting the notification, and at least partly in response to the instruction, to set a second status related to the first right;

transmit over a network to a second user second licensing terms defined by a licensor for a second media property;

receive over a network a license inquiry from the second user regarding at least a second right for the second media property;

receive a response from the second user to the second licensing terms, the second user response including a license acceptance, a counteroffer, or an indication that the second user is not proceeding with the licensing transaction;

set a second status in real-time related to the second right at least partly in response to the second user response;

transmit a notification relating to the user response to a recipient designated by the licensor; and

receive an instruction from the licensor after transmitting the notification, and at least partly in response to the instruction, to set a second status related to the second right.

26. The apparatus as defined in Claim 25, wherein the user inquiry specifies a license time period.

27. The apparatus as defined in Claim 25, wherein the user inquiry specifies a territory for the license, including a governmental and/or a geographic regional territory.

28. The apparatus as defined in Claim 25, wherein the user inquiry specifies a media language that is a human language.

29. The apparatus as defined in Claim 25, wherein the licensing terms include a payment due date.

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X. EVIDENCE APPENDIX

None.

XI. RELATED PROCEEDINGS APPENDIX

None.



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